


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number <b>Q68888</b>	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number <b>10/091,394</b>	Filed <b>March 7, 2002</b>	
	First Named Inventor <b>Atsushi YOKOUCHI</b>		
	Art Unit <b>1764</b>	Examiner <b>Ellen M. McAvoy</b>	
<p style="text-align: center;">WASHINGTON DC SUGHRUE/265550</p> <p style="text-align: center;"><b>65565</b></p> <p style="text-align: center;">CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number    <u>33,276</u></p> <div style="text-align: right;">         _____        Signature     </div> <div style="text-align: right;">       _____        Abraham J. Rosner        Typed or printed name     </div> <div style="text-align: right;">       _____        (202) 293-7060        Telephone number     </div> <div style="text-align: right;">       _____        October 15, 2007        Date     </div>			

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q68888

Atsushi YOKOUCHI, et al.

Appln. No.: 10/091,394

Group Art Unit: 1764

Confirmation No.: 9620

Examiner: Ellen M. McAvoy

Filed: March 7, 2002

For: ROLLING BEARING

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated May 31, 2007, Appellants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal and Petition and payment for an Extension of Time (for two (2) months).

As indicated in the Advisory Action dated September 11, 2007, for purposes of appeal, the proposed Amendment under 37 C.F.R. § 1.116 filed August 28, 2007 will be entered.

Claims 18-26 are pending. Claims 1-17 have been canceled.

Appellants turn now to the rejections at issue.

At issue is whether the presently claimed subject matter as described in independent claims 18, 19 and 20 is rendered obvious by the disclosure of JP-A-9-169989 to Yokouchi et al in view of U.S. Patent No. 6,010,984 to Heimann et al. Also at issue is whether the subject

matter as claimed in independent claims 18, 19 and 20 is rendered obvious by the disclosure of U.S. Patent No. 5,728,659 to Naka et al in view of Heimann et al and Yokouchi et al. Appellants respectfully submit that the rejections are improper and that the final rejection should be withdrawn and the subject application allowed.

Claims 18-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yokouchi et al, in view of Heimann et al.

The Examiner maintained that a person having ordinary skill in the art, armed with the disclosure of Heimann et al, would have found it obvious to add a pH adjustor to the grease composition of Yokouchi et al in order to adjust the pH to “about 7 to about 14,” and to tailor the grease to be compatible with the metal surface which contacts the grease, with a reasonable expectation of enhancing corrosion resistance.

Appellants respond as follows.

Yokouchi et al does not disclose a grease composition comprising a pH adjustor, as recited in Applicants’ claims 18-20. On the other hand, the grease compositions of Heimann et al and Yokouchi et al sufficiently differ such that one skilled in the art would not contemplate addition of a pH adjustor to the grease composition of Yokouchi et al with a reasonable expectation of success. Further in this regard, Heimann et al is entirely silent with respect to application to a rolling bearing which is the subject matter of the present claims. See col. 9, lines 9-30 of Heimann et al. Application to pipes, cables and battery terminals as taught by Heimann et al does not instruct, disclose or otherwise suggest application to a rolling bearing.

For the above reasons, Appellants respectfully request reconsideration and withdrawal of the §103(a) rejection of claims 18-24 over Yokouchi et al in view of Heimann et al.

Claims 18-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naka et al in view of Heimann et al.

The Examiner maintained that it would have been obvious to add a pH adjustor as taught by Heimann et al to the grease composition of Naka et al for the same reasons as noted above.

Appellants traverse the rejection for the same reasons as set forth with respect to the rejection over Yokouchi et al in view of Heimann et al. Particularly, the disclosure in Heimann et al in no manner leads one skilled in the art to employ a pH adjustor in the grease composition of a rolling bearing. Appellants do not claim a grease composition *per se*, but rather a rolling bearing having a grease composition sealed into the annular space formed by the rolling elements and the races. Table 5 at page 70 of the specification shows criticality in the pH of the grease in providing good durability and in retarding grease leakage *in a rolling bearing*.

For the above reasons, Appellants respectfully request reconsideration and withdrawal of the §103(a) rejection of claims 18-24 over Naka et al in view of Heimann et al and Yokouchi et al.

Accordingly, it is respectfully submitted that the claims on appeal are patentable over the applied prior art, and Appellants respectfully request withdrawal of the final rejection upon review by the Pre-Appeal panel.

PRE-APPEAL BRIEF REQUEST FOR REVIEW  
U.S. Application No. 10/091,394

Attorney Docket No.: Q68888

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Abraham J. Rosner  
Registration No. 33,276

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

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Date: October 15, 2007